

REMARKS

The final Office Action dated April 14, 2009 was received and carefully reviewed.

By this response, no claims have been amended, no claims have been canceled, and no claims have been amended. Thus, claims 1-26 remain pending in the instant application.

Applicant respectfully requests reconsideration and allowance of the above-identified application in view of the above amendments and the following remarks.

Claim Rejections - 35 U.S.C. § 101

Claims 1-14 and 24-26 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant traverses this rejection for at least the following reasons.

Applicant contends that electronic data is changed using the operation method as seen in claims 1-14 and 24-26, and thus satisfies a transformation as defined by the present “Machine-or-Transformation” test as set forth under the Federal Circuit Court’s decision handed down in the case of *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008).

Accordingly, the subject matter of claims 1-14 and 24-26 is directed to statutory subject matter under 35 U.S.C. § 101, and thus it is requested that the rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 6, 8, 14, 16, 19, 21 and 23-26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Tschiegg et al.* (U.S. Pub. No. 2003/0160818 A1) (*Tschiegg*, hereinafter) in view of *Heinrich* (U.S. Pub. No. 2003/0046128 A1) (*Heinrich*, hereinafter). Claims 2-5, 7, 9-13, 15, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Tschiegg* in view of *Heinrich* and in further view of *Lovejoy et al.* (U.S. Pub. No. 2002/01238416 A1) (*Lovejoy*, hereinafter). Applicant traverses the rejections for at least the reasons set forth below.

Applicant contends that present independent claims 1 and 16, and the claims dependent therefrom, are patently distinguishable over *Tschiegg*, *Heinrich* and *Lovejoy*, since *Tschiegg* and *Heinrich* and *Lovejoy*, taken either alone or in combination, fail to disclose, teach or suggest all

of the features recited in the pending claims. For example, independent claim 1 (emphasis added) recites:

1. A computer-implemented method for assessing risk within an organization, comprising:
 - defining one or more zones, each of said one or more zones comprising an environment;
 - identifying one or more assets of said organization, each of said assets being located in a respective one of said zones;
 - conducting a respective impact assessment for each of said assets, each assessment comprising assessing the impact of the loss of said respective asset;**
 - conducting for each of said zones a respective zone risk assessment, comprising assessing the risk level associated with placing a respective asset within said respective corresponding zone;
 - conducting for each asset a respective asset risk assessment, comprising assessing the risk level associated with said respective asset independent of the respective zone of said respective asset; and
 - assessing risk on the basis of at least said impact assessment, said zone risk assessments and said asset risk assessments.

Independent claim 16 (emphasis added) recites:

16. An apparatus for assessing risk within an organization, comprising:
 - data input means for inputting asset information into a register of assets, each of said assets being an asset of said organization, each of said assets being located in a respective zone;
 - data storage for storing said register of assets, including for each of said assets said respective zone;
 - means for receiving or storing a respective zone risk assessment for each of said zones, said respective zone risk assessment comprising an assessment of the risk level associated with placing a respective asset within said respective corresponding zone;
 - means for receiving or storing a respective asset risk assessment for each asset, said respective asset risk assessment comprising an assessment of the risk level associated with said respective asset independent of the respective zone of said respective asset;
 - means for receiving or storing a respective impact assessment for each of said assets, each assessment comprising assessing the impact of the loss of said respective asset, and for assessing risk on the basis of at least said impact assessment, said zone risk assessments and said asset risk assessments to thereby form a risk assessment; and**

output means for outputting said risk assessment.

As seen above, independent claim 1 is directed to, *inter alia*, the features of conducting a respective impact assessment for each of said assets, each assessment comprising assessing the impact of the loss of said respective asset. As further seen above, independent claim 16 is directed to, *inter alia*, the feature of means for receiving or storing a respective impact assessment for each of said assets, each assessment comprising assessing the impact of the loss of said respective asset, and for assessing risk on the basis of at least said impact assessment, said zone risk assessments and said asset risk assessments to thereby form a risk assessment, as recited in present independent claim 16. Applicants contend that *Tschiegg, Heinrich and Lovejoy*, taken either alone or in combination, fail to disclose at least the above recited features with respect to present independent claims 1 and 16.

As seen on pages 6-7 of the Office Action, the Examiner alleges that *Tschiegg* discloses the feature of “conducting a respective impact assessment for each of said assets, each assessment comprising assessing the impact of the loss of said respective asset”, and cites paragraph [0019] if *Tschiegg* as allegedly disclosing this feature. However, paragraph [0019] of *Tschiegg* actually states:

[0019] In certain aspects, one system of the invention generates one or more of the following recommended cost-benefit analysis information through the graphics interface and over the network: total loss before implementation of a recommendation, total loss after implementation of a recommendation, property damage loss before implementation of a recommendation, property damage loss after implementation of a recommendation, business interruption loss before implementation of a recommendation, business interruption loss after implementation of a recommendation, estimated cost to complete, estimated cost to complete source, estimated probability, estimated probability source, and estimated annual risk avoidance. The estimated annual risk avoidance may for example include a factor of [(property loss before implementation of a recommendation+business interruption loss before implementation of a recommendation)-(property loss after implementation of a recommendation+business interruption loss after implementation of a recommendation)]/probability (in years).

As seen in the above passage, *Tschiegg* appears to merely disclose *determining loss before and after implementation of recommendation*. In the context of the present invention, the feature of “conducting a respective impact assessment for each of said assets, each assessment comprising assessing the impact of the loss of said respective asset”, which measures impact as a total loss of asset, is fundamentally different from the teachings in *Tschiegg* that determine loss before and after an implementation of recommendation.

Applicant further contends that the present invention computes loss based on the potential worst case consequential impacts. The impact criteria of the present invention are as follows: 1) Loss of Opportunity, 2) Loss of Productivity, 3) Loss due to Regulatory and Contractual Breaches, 3) Cost of System Investment, and 4) Loss due to Confidentiality Breaches. Thus, as clearly seen in the list of impact criteria, there is no consideration of risk analysis recommendations. Consequently, the rejection the Examiner’s rejection of the claims citing that *Tschiegg* discloses *determining loss before and after implementation of recommendation* is improper.

Furthermore, Applicant asserts that neither *Heinrich* nor *Lovejoy* make up for the deficiencies with respect to *Tschiegg*. For at least the reasons stated above *Tschiegg*, *Heinrich* and *Lovejoy*, taken either alone or in combination, fail to anticipate or render obvious each and every feature recited in present independent claims 1 and 16. Thus, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, Applicants respectfully request the withdrawal of the rejection of independent claims 1 and 16 under 35 U.S.C. § 103(a), and the allowance of these claims.

Claims 2-15 and 17-26 are allowable at least by virtue of their dependency from one of the independent claims, but also because they are distinguishable over the prior art.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. If, however, the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney/agent to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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